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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/027,343      | 12/19/2001  | Tony Looper          | VM6117              | 9618             |

7590 06/09/2005  
Kim Diliberti  
1430 Waukegan Road  
McGaw Park, IL 60085

| EXAMINER |
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VRETTAKOS, PETER J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3739

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                       |                                      |  |
|------------------------------|---------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/027,343  | <b>Applicant(s)</b><br>LOOPER ET AL. |  |
|                              | <b>Examiner</b><br>Peter J. Vrettakos | <b>Art Unit</b><br>3739              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/027,343  
Filing Date: December 19, 2001  
Appellant(s): LOOPER ET AL.

MAILED  
JUN 09 2005  
Group 3700

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Donald Nickey  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3-3-05.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

None.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 43-84 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

|                    |                       |               |
|--------------------|-----------------------|---------------|
| <b>5,486,185</b>   | <b>Freitas et al.</b> | <b>1-1996</b> |
| <b>GB 2227412A</b> | <b>Chien</b>          | <b>8-1990</b> |

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 43-84 are rejected under 35 U.S.C. 102 (b) as being anticipated by Freitas et al. This rejection is set forth in a prior Office Action, mailed on 10-28-04.

Claims 45,54,55,59,60,62,63,67,68,72,73,74,80, and 81 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Freitas et al. This rejection is set forth in a prior Office Action, mailed on 10-28-04.

Claims 46-48, 63-65, 69-70, 75-76, and 82-84 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Freitas et al. This rejection is set forth in a prior Office Action, mailed on 10-28-04.

**(11) Response to Argument**

The Examiner stands by the rejections above but in addition will address the Applicant's arguments by exhaustively applying yet another Freitas embodiment found in figures 9 and 10 to reject all claims.

A.

1. *Freitas discloses a hollow manipulation shaft internally receiving a prime mover.*
2. *Freitas is fully capable of imparting rotational force from the prime mover to the tool.*

Points 1 and 2 are elaborated below in bold.

All parentheticals refer to Freitas.

Freitas discloses a reconfigurable surgical apparatus (figure 10), comprising:

a surgical instrument assembly / “means for imparting a range of motion” (346 – rotational and longitudinal, 350 - longitudinal) formed with a **hollow manipulation shaft / “means for defining an intracorporeal passageway” (324) internally receiving a prime mover (316, “slidably engages”, col. 7:57-58) activated by an actuator (346, col. 8:18-21) located at a proximal end of the shaft;**

a coupler (distal end of figure 10) including a receiver/engager (318 and 320 combined) formed about a distal end having a capture ledge (318) and shelf (320) that defines a lateral slot (space between 318 and 322 depicted in figure 10); and

an interchangeable surgical tool (240 in figure 9; last sentence of Abstract) attachable to the coupler (analogue shown in figure 4) and including a frangible portion (proximal end of 240, further addressed below), and an anchor (242) having a shear notch (depicted, “t-shaped channel” col. 7:12) adapted to non-releasably mate to the capture ledge/receiver/engager (analogue shown in figure 4) **and capable of transferring (“rotatably engage”, col. 7:13) rotational force from the prime mover (316) to the tool (240) (col. 7:10-15; col. 7:42-45; col. 7:51-55; see limitations for “rotatably coupled” jaws in patented claims 1,3, and 5).**

Note: “internally receiving” is construed as a shaft that envelops a tube, such as Freitas’ shaft (324) enveloping the tubular probe (316).

Independent claims 52,57,78 and dependent claims 58, 79

Freitas discloses a reconfigurable surgical apparatus (figure 10), comprising:

a surgical instrument assembly formed with **a hollow manipulation shaft (324) internally receiving a prime mover (316, "slidably engages", col. 7:57-58) activated by an actuator (346, col. 8:18-21) located at a proximal end of the shaft;**

a coupler (distal end of figure 10) formed about a distal end having a anchor (242) having an engagement face (inherent) that defines a lateral slot (space between 318 and 322 depicted in figure 10); and

an interchangeable surgical tool (240 in figure 9; last sentence of Abstract) attachable to the coupler (analogue shown in figure 4), and a capture ledge (318) that defines a lateral slot/recess (space between 318 and 322 depicted in figure 10) adapted to mate to the anchor (242) **and capable of transferring rotational force from the prime mover (316) to the tool (240) (col. 7:10-15; col. 7:42-45; col. 7:51-55; see limitations for "rotatably coupled" jaws in patented claims 1,3, and 5).**

#### Dependent claims

Re: claims 45, 54, 55, 59, 60, 62, 63, 67, 68, 72, 73, 74, 80, and 81, Freitas discloses an anchor formed with two generally hook shaped tines/recess/projection (figure 9, formed by projections 242) with engagement faces (244).

Re: claims 46-48, 63-65, 69-70, 75-76, and 82-84, Freitas discloses tines with frangible portions, inherently that is sealed from the exterior environment by the coupler and the manipulation shaft as depicted in figure 4. Frangible is simply defined as "breakable". Of course the proximal section of element 240 in figure 9 is breakable.

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*3. Freitas discloses frangible (breakable) sections associated with the instrument head anchor.*

In figure 9, instrument 240 includes a proximal portion with a t shaped channel (elements 244 and 242). The analogue to 240 is seen in figure 8. The Office contends that section 122 because its width is not as great as section 200 is “breakable” or “frangible” in the same sense as is a wishbone. To this end, Freitas discloses a frangible section.

*4. Freitas’ frangible section leading to unwanted results (objects lost in the patient) is irrelevant.*

The application involves apparatus claims where rejections are based upon *structural equivalence* independent of usage or results from a certain structure/invention. As articulated above, Freitas discloses a frangible section (122 in figure 8). It is also noted that the frangible section is capable of being broken outside of the body. (The claim language does not require a breaking of the component during its use in the body.)

B.

- 1. The **35 USC § 103** rejection involving Chien has been dropped.*
- 2. Addressed above in A 1 and 2.*

C.

- 1. Made moot by the Chien related rejection being dropped.*



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Pete Vrettakos *PV*  
June 6, 2005

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